



**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

|                 |             |                      |                     |
|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

09/717,204 11/22/00 MORRISON

S 05725.0642-0

HM12/0702  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.  
1300 I STREET, N.W.  
WASHINGTON DC 20005-3315

EXAMINER

WILLIS, M

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

|                              |                 |                  |  |
|------------------------------|-----------------|------------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)     |  |
|                              | 09/717,204      | MORRISON, SAM B. |  |
|                              | Examiner        | Art Unit         |  |
|                              | Michael Willis  | 1619             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) ____.   |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 20) <input type="checkbox"/> Other:  |

### **DETAILED ACTION**

Claims 1-28 are pending. Claims 1-26 are drawn to compositions comprising a linear dimethicone and a block copolymer. Claim 27 is drawn to a cosmetic delivery system. Claim 28 is drawn to a method of delivering a powder composition to a keratinous substance.

#### ***Claim Objections***

Claim 25 is objected to because of the following informality: the claim lacks a period. Each claim should begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. See MPEP 608.01(m). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 5, 13, 14, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the variable  $n$  is undefined. Claim 5 lacks antecedent basis for "said dimethicone polyols" because claim 1, from which claim 5 depends, does not use the phrase "dimethicone polyols". Claim 13 is confusing because of the phrase "powder is chosen form". Additionally, claim 13 lists "pearling agents" twice. Claim 25 lacks antecedent basis for "said at least one additional film former".

Any remaining claims are rejected for depending from indefinite base claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 2, 6, 7, 8, 9, 10, and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reusch (US Pat. 5,928,632). Reusch discloses formulations for comparison of deposition on skin and emulsion stability. Comparative Formula B in Table 1 (see columns 5 and 6, lines 40-67 and columns 7 and 8, lines 1-25) is comprised of dimethicone, cetyl esters wax, and GESHLNE AJ, described as butylene/ethylene/styrene copolymer and ethylene propylene styrene copolymer.

Claims 1, 2, 6, 9, 10, 12, 13, 15, 16, 22, 23, and 27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Knitowski et al (US Pat. 6,248,339 B1). Knitowski discloses a fragrant body lotion and cream (see abstract). A formulation is disclosed comprising a dimethicone crosspolymer, a hydrogenated butylene ethylene styrene copolymer, and ethylene propylene styrene copolymer (see Table 1, line 50 through col. 4, line 15). The lotion further comprises a titanium dioxide/mica/zinc oxide opacifying agent and silica powder. Knitowski discloses that a benefit of the lotion

system is that it provides a fragrance lift and lengthens the duration of the fragrance (see col. 2, lines 45-56). It is the position of the examiner that this meets the limitation of a fragrance delivery system.

Claims 1, 4, 5, 6, 9, 10, 12, 13, 15, 22, 24, 25, and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Curtis et al (WO 98/42298). Curtis discloses wear resistant cosmetics. An example of a pigmented foundation includes laurylmethicone copolyol, a mixed block copolymer, cosmetic powder, cosmetic pigment, and bentone gel (see Example 4, page 10, lines 8-32). The mixed block copolymer is described as a styrene-ethylene/propylene mixed block copolymer (see page 2, line 20 through page 4, line 7). It is the position of the examiner that bentone gel meets the limitation of an additional film-former.

Claims 1, 6, 9, 10, 12, 13, 14, 15, 17, 18, 21, 22, 23, 27, and 28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Konik et al (US Pat. 6,060,072). Konik discloses transfer resistant color cosmetic compositions. A disclosed example includes styrene-ethylene-propylene copolymer, trimethylsiloxysilicate, iron oxides, and methicone (see col. 4, lines 1-25). The compositions are disclosed as useful in mascaras, which inherently deliver compositions to keratinous substances (see col. 1, lines 45-62).

Claims 1, 3, 11, and 19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Anton et al (US Pat. 6,066,313). Anton discloses cosmetic compositions comprising a polymer and an oil component (see abstract; and col. 9, lines 47-64). The monomeric components of the polymer include styrene, propylene, and butylene (see

col. 3, lines 9-20). Linear polydimethylsiloxanes are disclosed (see col. 5, lines 1-13; and col. 11, lines 10-27). Additional polydimethylsiloxanes are disclosed (see col. 8, lines 33-60).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis et al (WO 98/42298) in view of Anton et al (US Pat. 6,066,313), Konik et al (US Pat. 6,060,072), and Kimura (US Pat. 4,528,390).

Curtis teaches wear resistant cosmetics. The cosmetics are comprised of styrene-ethylene/propylene mixed block copolymers (see abstract). Cosmetic applications include mascara and lipstick (see page 2, lines 20-22). The use of mascara comprising a powder meets the limitation of a method of delivering a powder composition to a keratinous substance. Alkyl cycloalkylacrylates are also included, meeting the limitation of an additional film former (see page 5, line 11 through page 6, line 14). Additional components include wax, powder, non-volatile oil, and a volatile solvent in an amount from 0.01 to 85 weight percent (see page 6, lines 15-17; page 8, lines 17-30; and page 4, lines 17-19). Dimethicone/cyclomethicone is taught as a preferable volatile solvent base (see col. 4, lines 17-29). Example 4 includes

laurylmethicone copolyol (see page 10, lines 10-31). The reference lacks polymethylsilsesquioxanes, trimethylsiloxysilicates, polyethylene polymers, and specific linear dimethicones.

Anton teaches the use of linear volatile silicones with 9 or fewer silicon atoms as volatile solvents in cosmetics. The oils include hexamethyldisiloxane (see col. 5, lines 1-13). The volatile oils enable easy formulation and leave the non-volatile ingredients on the skin (see col. 4, lines 35-53).

Konik teaches the use of film-forming agents in transfer resistant cosmetic compositions. Konik teaches that the film-forming agent provides waterproofing properties, improve the wear of the composition, and confer transfer-resistance to the makeup product (see col. 2, lines 17-34). Trimethylsiloxysilicate and polyethylene polymers are taught as a useful film-forming agent.

Kimura teaches the preparation of polymethylsilsesquioxanes. The title compounds are taught as useful anti-caking agents for powder products and as additives for cosmetics (see col. 3, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Curtis by the incorporation of linear volatile silicones for the ease of formulation imparted by the silicones as taught by Anton, by the addition of trimethylsiloxysilicate and polyethylene polymers for the improved properties of the film-forming agents as taught by Konik, and by the incorporation of polymethylsilsesquioxanes for their anti-caking properties in cosmetics as taught by Kimura.

Claims 1 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusch (US Pat. 5,928,632). Reusch teaches formulations for deposition on skin and emulsion stability. Comparative Formula B in Table 1 (see columns 5 and 6, lines 40-67 and columns 7 and 8, lines 1-25) is comprised of dimethicone, cetyl esters wax, and GESHLENE AJ, described as butylene/ethylene/styrene copolymer and ethylene propylene styrene copolymer. The test of emulsion stability of Comparative Formula B showed no separation of the emulsion after 24 hours.

It would have been obvious to one of ordinary skill at the time the invention was made to have included the components of the comparative example as taught by Reusch for the benefit of their stabilizing properties in emulsions.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5 p.m..

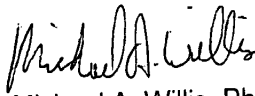
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2742 for regular communications and (703) 308-2742 for After Final communications.

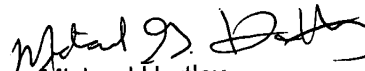


Application/Control Number: 09/717,204

Art Unit: 1619

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
Michael A. Willis, Ph.D.  
Patent Examiner  
June 22, 2001

  
Michael Hartley  
Primary Examiner  
Art Unit 1619